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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,452	11/07/2000	Joseph C. Fjelstad	TESSERA 3.0-051 FWC DIV	8689

530 7590 09/25/2002

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EXAMINER
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CHANG, RICK KILTAE

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 09/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/707,452

Applicant(s)

FJELSTAD, JOSEPH C.

Examiner

Rick K. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 and 39-47 is/are pending in the application.
- 4a) Of the above claim(s) 39-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species I in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. The abstract of the disclosure is objected to because the abstract does not describe a method of fabricating interconnection members sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 5, line 2: What is "its" referring to?

Claim 8, line 2: "the exposed surface of each of the posts" lacks positive antecedent basis.

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Claims 11, line 3: "a first surface above a second surface of the dielectric sheet" renders the claim vague and indefinite. Where is this dielectric sheet in claim 1? Is there a third layer on the substrate and sheet? Is a first and second surfaces referring to the sheet or substrate? Claim 11 has ambiguous terminology which is unclear whether later recitation of originally recited terms is intended to refer to the originally recited terms.

NOTE: No art rejections have been applied to the claims 8 and 11-17 since there are a great deal of confusion and uncertainty as to the proper interpretation of the limitations of claims. Therefore, it would not be proper to reject such claims on the basis of prior art. See MPEP 2173.06.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1, 9 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Otsuki et al (US 5,653,891).

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Otsuki discloses a substrate 11, a conductive layer 9 and substantially all the claimed limitations.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuki et al (US 5,653,891) in view of Hoover et al (US 4,666,735).

Otsuki discloses cooling towers.

Otsuki fails to disclose a flexible dielectric substrate and between 125 and 500 micron conductive layer thickness.

Hoover discloses that a resist is a flexible dielectric substrate (col. 3, lines 54-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Otsuki by providing a flexible dielectric substrate, as taught by Hoover, for the purpose of withstanding the etching process during circuit formation.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide a conductive layer thickness between 125 and 500 microns because Applicant has not disclosed that incorporating a conductive layer thickness between 125 and 500 microns provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the thickness as disclosed in the Otsuki

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reference. Therefore, it would have been an obvious matter of design choice to modify Otsuki to obtain the invention as specified in claim 7.

10. Claims 10 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuki et al (US 5,653,891) in view of Official Notice.

Otsuki discloses applying a resist layer includes metallic portions (13), developing and removing the resist layer.

Otsuki fails to disclose applying a photo resist layer, selectively developing the photoresist layer and providing a nickel metallic layer.

Official Notice is taken that it is well known in the art to apply a photo resist layer, selectively develop the photoresist layer and provide a nickel metallic layer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Otsuki by applying a photo resist layer, selectively developing the photoresist layer and providing a nickel metallic layer, as taught by Official Notice, for the purpose of etching a metal layer.

### *Conclusion*

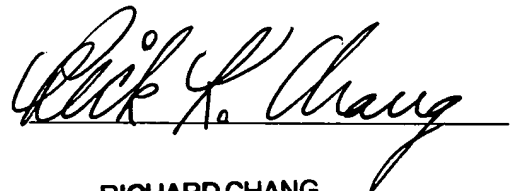
**11. Applicants are duly reminded that a full and proper response to this Office Action that includes any amendment to the claims and specification of the application as originally filed requires that the applicant point out the support for any amendment made to the disclosure, including the claims. See 37 CFR 1.111 and MPEP 2163.06.**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rick K. Chang whose telephone number is (703) 308-4784. The examiner can normally be reached on 5:30 AM to 1:30 PM.

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The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, appearing to read "Rick H. Chang", written over a horizontal line.

**RICHARD CHANG  
PRIMARY EXAMINER**

RC  
September 20, 2002